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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/638,404

08/12/2003

Nachman Eckstein

26253

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7590

08/02/2006

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EXAMINER

GILBERT, ANDREW M

ART UNIT

PAPER NUMBER

3767

DATE MAILED: 08/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/638,404	Applicant(s) ECKSTEIN ET AL.	
	Examiner Andrew M. Gilbert	Art Unit 3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-18 is/are rejected.
- 7) ☒ Claim(s) 19 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This office action is in response to the reply filed on 6/2/206.
2. In the reply, the Applicant amended claims 1 and 5 and cancelled claim 4.

Drawings

3. The drawings are objected to because photographs are not permitted (see Fig 2) and the lines, numbers are not uniformly thick and well defined, and copy machining marks are not accepted. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Claims 19 and 20 are objected to because of the following informalities: Claims 19 and 20 reference claim limitations from claim 1 and 11 respectively, but are independent claims. This is improper. The claims limitations referenced from claims 1 and 11 must be directly recited in the claim itself. Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 5-8, 10-11, 14-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Kulisz et al (5000739). Kulisz et al discloses a motorized syringe for producing a controlled, slow-delivery of a fluid-like substance, comprising: a housing (14) having, at one end, an expansible-contractible chamber (46), and an outlet (56); and a drive (11) at the opposite end of said housing, said drive including an electrical motor (34) and a plunger (38) driven by said electrical motor; said housing comprising a first section housing said expansible-contractible chamber and a second section housing said drive (Fig 1); said drive including a threaded sleeve fixed to said plunger, a threaded shaft engageable with said threaded sleeve for axially displacing the sleeve and the plunger fixed thereto upon the rotation of the threaded shaft (32, 33, Fig 1), and a step-down transmission coupling said threaded shaft to said motor for rotating said shaft, and thereby for axially displacing said sleeve and plunger fixed thereto at a slow

rate upon the energization of said motor (32, 33, Fig 1; Summary); said first housing section including a septum (col 2, lns 40-55); wherein the expansible-contractible chamber is defined by a bellows-type container (Fig 1); outlet including a flexible catheter tube (col 2, lns 58-53; col 4, lns 17-20); housing being bio-compatible material and delivering a medical preparation thereto at a slow rate for a prolonged period of time (Summary); and being sized and configured so that it is possible it could fit inside the vaginal of a human female and including a flexible catheter tube of a length for introduction into the uterus of the female (Fig 1; Summary).

7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Smith et al (5690618). Smith et al discloses a motorized syringe for producing a controlled, slow-delivery of a fluid-like substance, comprising: a housing (14) having, at one end, an expansible-contractible chamber (Fig 2a), and an outlet (70); and a drive (42) at the opposite end of said housing, said drive including an electrical motor (82) and a plunger (78) driven by said electrical motor (col 4, lns 25-46); said housing comprising a first section housing said expansible-contractible chamber and a second section housing said drive (Fig 2a); said first housing section including a septum (74).

8. Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by Pokras (5647851). Pokras discloses a motorized syringe for producing a controlled, slow-delivery of a fluid-like substance, comprising: a housing (56) having, at one end, an expansible-contractible chamber (14), and an outlet (50); and a drive (34) at the opposite end of said housing, said drive including an electrical motor (34) and a plunger (48) driven by said electrical motor; said housing comprising a first section housing said

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expansible-contractible chamber and a second section housing said drive (Fig 6); said drive including a threaded sleeve fixed to said plunger, a threaded shaft engageable with said threaded sleeve for axially displacing the sleeve and the plunger fixed thereto upon the rotation of the threaded shaft (38; 40; 42; 84; Fig 6), and a step-down transmission coupling said threaded shaft to said motor for rotating said shaft, and thereby for axially displacing said sleeve and plunger fixed thereto at a slow rate upon the energization of said motor (38; 40; 42; 84; Fig 6).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2-3, 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kulisz et al or Smith et al or Pokras in view of Uytenbogaart (2752918). Kulisz et al or Smith et al or Pokras discloses the invention substantially as claimed except for first and second housing sections being separate sections having interconnecting thread elements at their ends. Uytenbogaart teaches that it is known to have first and second housing sections being separate sections having interconnecting thread elements at their ends (Fig 9-11) for the purpose of allowing easy loading of ampoules (col 1, lns 29-31). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the housing as taught by Kulisz et al or Smith

et al or Pokras with the threaded attaching housing segments as taught by Uytenbogaart for the purpose of allowing easy loading of ampoules (col 1, Ins 29-31).

11. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kulisz et al in view of Smith et al. Kulisz et al discloses the invention substantially as claimed except for a motor control circuit included in a separate unit having mounting means for mounting the separate unit externally of the patient's body. Smith et al teaches that it is known to have a motor control circuit included in a separate unit having mounting means for mounting the separate unit externally of the patient's body (118; Fig 2b; col 6, Ins 5-13) for the purpose of decreasing syringe size (col 6, Ins 5-13). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the motor control circuit as taught by Smith et al with the external circuit as taught by Smith et al for the purpose of decreasing the size of the device.

Allowable Subject Matter

12. Claims 19 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

13. Applicant's arguments with respect to claims 1-3, 5-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

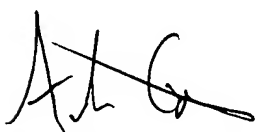
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew M. Gilbert whose telephone number is (571)

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272-7216. The examiner can normally be reached on 8:30 am to 5:00 pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571)272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Andrew Gilbert

KEVIN C. SIRMONS
SUPERVISORY PATENT EXAMINER

